

Application Serial No. 09/811,417
Amendment dated October 12, 2004
Reply to Office action of August 11, 2004

REMARKS

Claims 2, 4 through 10 and 12 through 18 are pending in this application. Claims 12, 16, and 17 are amended herein in order to claim the invention more clearly and not for any reason of patentability. Support for the amendments to claims 12, 16, and 17 may be found in the claims as filed originally. In particular, claim 16 now includes the recitation of former claim 3, and claims 12 and 17 are now in independent form. Claim 3 has been cancelled without prejudice or disclaimer. Entry of this amendment is requested respectfully. Further reconsideration is requested based on the foregoing amendments and the following remarks.

Claim Rejections - 35 U.S.C. § 103:

Claims 13, 14, 16, and 18 were rejected under 35 U.S.C. § 103 as being unpatentable over Nakamura *et al.* US 6,280,304 in view of the Takahashi *et al.* US 4,483,216. The rejection is traversed. None of the cited references disclose or indicate the constituent features of former claim 3, in particular the coupling member, and accordingly, claims 13, 14, 16, and 18 are submitted to be in condition for allowance.

Furthermore, there is no teaching or suggestion in either Nakamura or Takahashi to combine the two references. Nakamura, for example, already transmits power. Nakamura is complete in itself. It is submitted that no person of ordinary skill in the art at the time the invention was made would have seen any reason to modify Nakamura as proposed in the Office action.

The Office action provides no motivation or suggestion to combine the teachings of Okano *et al.* ('276), Okano *et al.* ('484), and Hora *et al.* ('822) as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D). The Office action asserts, merely, that "(i)t would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Nakamura *et al.* with reduction gear as taught by Takahashi *et al.* to improve transmission of power, (Takahashi *et al.* cols. 1 and 2)."'

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), cert. denied, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some

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teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See *In re Rouffet*, 47 USPQ2d at 1457.

If identification of each claimed element in the prior art were sufficient to negate patentability, the Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the Office action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

Nakamura uses gears to transmit power in his abrasive machine, as described at column 1, lines 14 and 67, and column 2, lines 1, 8, 9-11, 16-21, et seq. Takahashi, however, is discussing problems inherent in *planetary-roller* transmissions, not planetary-gear transmissions, at column 1, lines 6, 12, 15, 18, 22, 27, 29, 34, 44, 51, and 59. The problems discussed by Takahashi are not, therefore, applicable to a planetary gear transmission such as that used by Nakamura at all. It is submitted therefore, that persons of ordinary skill in the art who read the litany of problems associated with planetary-roller transmissions described by Takahashi at column 1, lines 33 through 64 would have been deterred from replacing the perfectly acceptable planetary gear transmission of Nakamura with the apparently problem-plagued planetary-roller transmission of Takahashi.

Furthermore, Takahashi is describing solutions applicable to planetary-roller transmissions, not planetary-gear transmissions, at column 1, lines 65-68, continuing at column 2, lines 4, 5, and 22-28. The solutions prescribed by Takahashi are not, therefore, even applicable to a planetary gear transmission such as that used by Nakamura. Thus, even if the improvements proposed by Takahashi to improve power transmission in planetary-roller transmissions were thought to improve power transmission in planetary-roller transmissions, there is no reason to believe that persons of ordinary skill in the art at the time of the invention would have seen fit to apply any of them to the planetary-gear transmission of Nakamura. Consequently, there is no reason to believe that persons of ordinary skill in the art at the time the invention was made would have considered replacing the reduction gears used by Nakamura with the rollers of Takahashi as a good way to improve transmission of power,

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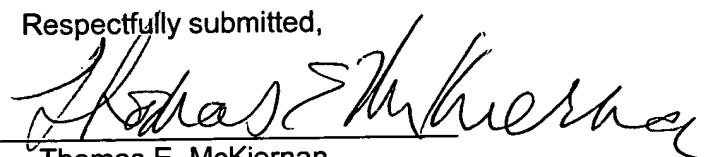
contrary to the assertion in the Office action. Claims 13, 14, 16, and 18 are thus submitted to be allowable. Withdrawal of the rejection of claims 13, 14, 16, and 18 is earnestly solicited.

Allowable Subject Matter:

The Applicant acknowledges with appreciation the allowance of claims 9, 10, and 15, and the indication that claims 2, 4 through 8, 12, and 17 contain allowable subject matter.

Conclusion:

Allowance of all claims 2, 4 through 8, 12, and 17 and of this entire application are therefore respectfully requested.

Respectfully submitted,
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